

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-50 were filed in the application. Claims 1-10, 12, and 14-50 were previously canceled, and claims 51 to 52 were previously added. In this Amendment, Applicants cancel claims 11, 13, 51, and 52, and add new claims 53-58. Thus new claims 53-58 are pending and under examination.

Support for new claims 53-58 can be found throughout the specification, for example, as follows:

<u>Claim</u>	<u>Support</u>
53	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
54	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
55	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
56	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
57	Original claim 13.
58	Page 11, ll. 20-35.

Applicants submit that these claim amendments are fully supported by the specification, do not introduce new matter or require a further search of the art, and respectfully request their entry.

Restriction

In a restriction requirement in the Office Action dated May 21, 2003, the Office required restriction under 35 U.S.C. §§ 121 and 372 between Group I, claims 11, 13 and 51, drawn to polynucleotides, and Group II, claim 52, drawn to polypeptide. (Office

Action at items 1-3.) Applicants elect to prosecute Group I, drawn to polynucleotides.

Applicants submit that new claims 53-58 are drawn to the elected invention.

In an Office Action dated March 13, 2003, the Office required election of a single species. Applicants provisionally elected sequence (g) of claim 11, with traverse. However, in the subsequent Office Action of May 21, 2003, the Office examined all of the sequences contained within SEQ ID NO:1 (see Tab A). Applicants respectfully request clarification that the species restriction of March 13, 2003, was waived.

Objections to the Specification

The Office noted a discrepancy between claim 11, section (a), which recited nucleotide 1,695,944 through nucleotide 1,696,441 of the *Mycobacterium tuberculosis* chromosome as being contained within SEQ ID NO:1, and the specification as filed, which describes SEQ ID NO:1 as beginning at its 5' end at position 1,696,015 of the *Mycobacterium tuberculosis* chromosome. (Office Action at Item 5.) Applicants confirm that the specification as filed is correct in ascribing the 5' end position of SEQ ID NO:1 as 1,696,015 of the *Mycobacterium tuberculosis* chromosome, and have amended new claims 53 and 55 to recite the correct 5' end position.

Claim Rejections under 35 U.S.C. § 112, First Paragraph, Written Description

The Office rejected claims 11, 13, and 51 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor was in possession

of the claimed invention. In particular, the Office highlighted the discrepancy between the 5' end of SEQ ID NO:1 as defined in the specification (position 1,696,015 of the *Mycobacterium tuberculosis* chromosome) and Applicants' claims for sequences extending beyond this boundary.

In pertinent part, the Office stated:

With the exception of SEQ ID NO:1, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. In this case, nucleotide numbers 1,695,944 through nucleotide 1,696,014 of the *Mycobacterium tuberculosis* chromosome is [sic] missing from SEQ ID NO:1.

(Item 7, Office Action dated May 21, 2003.)

Applicants have canceled claims 11, 13, and 51, which included claims to the missing region of the *Mycobacterium tuberculosis* chromosome. New claims 53-56 instead claim polynucleotide sequences contained within SEQ ID NO:1. Each of the claimed nucleotide sequences uses either the 5' or 3' end of SEQ ID NO:1, as well as the 5' or 3' end position of each of the ORF's therein, to define the boundaries of the claimed polynucleotides. (Claims 53-56 as compared to schematic at Tab A.) Applicants have thus defined the claimed nucleic acid sequences. Applicants further note that new claims 57 and 58 recite stringent hybridization conditions.

Applicants thus respectfully request the withdrawal of the 35 U.S.C. § 112, first paragraph, written description rejection.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Claim Rejections under 35 U.S.C. § 102(a)

The Office rejected claims 11, 13, and 51 under 35 U.S.C. § 102(a), alleging that the claims were anticipated by Cole et al, which published on June 11, 1998. (Nature, (1998), Vol. 393(6685): 537-544.) (Office Action at item 9.) The current Application was filed as PCT/IB99/00740 on April 16, 1999. In turn, PCT/IB99/00740 claimed priority to U.S. Application No. 09/060,756, filed April 16, 1998. A substitute Declaration filed in the present application on December 6, 2001, included a claim to priority to U.S. Application No. 09/060,756. (Copy at Tab B.)

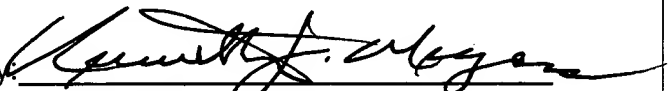
Applicants submit that the priority date of April 16, 1998, precedes the prior art document, which is dated June 11, 1998. Applicants further submit that new claims 53-58 are fully supported in the priority document. A copy of the priority application, Serial No. 09/060,756, is filed herewith for the Examiner's convenience. Consequently, the Cole et al. publication is not prior art under § 102(a). Applicants thus respectfully request the withdrawal of the 35 U.S.C. § 102(a) rejection.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 21, 2003

By: 

Kenneth J. Meyers

Reg. No. 25,146

Phone: (202) 408-4000

Fax: (202) 408-4400

E-mail: ken.meyers@finnegan.com

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com